

## **REMARKS**

Reconsideration of the application in view of the present amendment is respectfully requested.

By the present amendment, the specification has been amended to correct a formal error therein. Claims 2, 9, 11 have been amended to delete the informalities therein noted by the Examiner, whose suggestions for amending the claims are appreciated. The presently pending Abstract of the Disclosure has been canceled and has been substituted by a new one.

Based on the foregoing amendments and the following remarks, the application is deemed to be in condition for allowance and action to that end is respectfully requested.

### **I. Objection to the Drawings**

The Examiner objected to the drawings under 37 C.F.R. § 1.84(p)(5) for including a reference numeral not mentioned in the description. It is respectfully submitted that the above-mentioned amendment of the specification overcomes the Examiner's objections to the drawings, and it is respectfully requested that the objection to the drawings be withdrawn.

## **II. Objections to the Specification**

The Examiner objected to the specification for a formal error therein and for an improper form of the Abstract. As noted above, the present amendment corrects the formal error in the specification and replaces the pending Abstract with a new one. In view of the above, it is respectfully requested that the objections to the specification be withdrawn.

## **III. Objection to and Rejection of Claims**

### **IIIa. Objections to the Claims**

The Examiner objected to claims 2, 9, and 11 for informalities therein. As noted above, claims 2, 9, and 11 have been amended to eliminate the informalities therein noted by the Examiner.

### **IIIb. Rejection of Claims**

The Examiner rejected Claim(s) 1-6, 8 and 9 under 35 U.S.C. § 103(a) as being unpatentable over Asak, U.S. Patent No. 4,860,838 (Asak). Claims 1-7, 10, 11 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Despres U.S. Patent No. 6,341,925 (Despres).

It is respectfully submitted that claims 1-11 are patentable over the cited references. Specifically, claim 1 recites that the tool holder has an end-side splined profile having an outer thread forming radial spline projections of the spline profile.

As explained in the specification forming radial spline projections of the spline profile by an outer thread permits mounting of both conventional core bit having an inner thread and annular core bit having a complementary inner spline profile.

The Examiner recognizes that neither Asak nor Despres disclose or suggest a tool holder with radial spline projections of a spline profile which are formed by an outer thread but takes Official Notice “that outer threads or protrusions are well known in the art to increase the frictional engagement between two objects thus increasing the strength of the connection,” asserting that it would have been obvious to modify the spline profile of Asak to include an outer thread.

Applicant respectfully disagrees with this assertion. Even assuming, *arguendo*, that using an outer threads to increase the frictional engagement between the objects is a “common knowledge,” it would not make the present

invention obvious because the object of the invention is not to increase the strength of connection of the holder with the core bit but to provide a tool holder capable to receive two types of core bits, a core bit having an inner thread and a core bit with an inner spline profile.

Moreover, the increase of the strength of connection would have been contrary to the inherent teaching of Asak that requires a rather easy disengagement of a holder from the bit.

Furthermore, the Office Action contains no evidence that the fact asserted to be well-known is indeed well known and is capable of being demonstrated instantly and unquestionably, as required by *Ahlert*, 165 USPQ 418, 420 (CCPA1970). The case law holds that

It is never appropriate to rely solely on “common knowledge” in the art without evidentiary support in the record, as the principal evidence upon which a rejection was based. *Zurko*, 59 USPQ2d at 1697 (Fed. Cir. 2001).

No such evidentiary support is found in the Office Action.

The Court of Appeals for Federal Circuit further held that “common knowledge” of one skilled in the art is not a substitute for specific evidence. *In re Lee*, 61 U.S.P.Q. 2d 1430 (Fed. Cir. 2002).

In view of the above, it is respectfully submitted that the present invention, as defined by claim 1, is not obvious over Asak or Despres, and claim 1 is patentable over both Asak and Despres.

Claims 2-10 depend on claim 1 and are allowable as being dependent on an allowable subject matter.

Claim 11 relates to a tool assembly with a tool holder of claim 1 and is allowable for the same reasons claim 1 is allowable.

## CONCLUSION

In view of the foregoing, it is respectfully submitted that the application is in condition for allowance, and allowance of the application is respectfully requested.

Should the Examiner require or consider it advisable that the specification, claims and/or drawings be further amended or corrected in formal respects in order to place the case in condition for final allowance, it is respectfully requested that such amendment or correction be carried out by Examiner's Amendment and the case passed to issue. Alternatively, should the Examiner feel that a personal discussion might be helpful in advancing this case to allowance, the Examiner is invited to telephone the undersigned.

Respectfully submitted,

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This correspondence is being deposited with the United States Postal Service on December 29, 2005 in an envelope as "Express Mail Post Office to Addressee" Mailing Label Number **ER 059 675 042 US** addressed to the Honorable Commissioner for Patents, Alexandria, VA 22313-1450.

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